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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,816	03/21/2001	Masahiko Honda	040405/0334	1908

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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,816

Applicant(s)

HONDA, MASAHIKO

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This case has been reassigned to a new Examiner.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Response to Amendment

3. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Pannu (U.S. Patent No. 6,735,741).

6. In regard to claims 1, 8, 15, 23, 29 and 30 Pannu discloses *a means for separating the electronic mail into first data including text data and second data when the received electronic mail includes the second data; means for inserting an identifier associated with the second data into the first data; and means for sending only the first data with the identifier to the receiving terminal; wherein the identifier permits retrieval of the second data by the receiving terminal.* Pannu discloses an e-mail message with a

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link to another portion of data stored externally from the e-mail message, which can be retrieved upon activating said link. See Pannu, Abstract; column 1, lines 21-30; column 1, lines 35-50; column 2, lines 15-20; column 2, lines 29-31; column 2, lines 34-38; column 4, lines 35-47. By this rationale claims 1, 8, 15, 23, 29 and 30 are rejected.

7. In regard to claims 2, 9 and 16, Pannu is applied as in claims 1, 8 and 15. Pannu further discloses *means for storing the second data; wherein the first data with the identifier inserted therein is sent by said sending means to the receiving terminal through the communication line*. See Pannu, column 4, lines 35-39. By this rationale claims 2, 9 and 16 are rejected.

8. In regard to claims 3, 10 and 17, Pannu is applied as in claims 2, 9 and 16. Pannu further discloses *the second data stored in said storing means is sent to the receiving terminal or deleted from the storing means in response to a request from the receiving terminal*. See Pannu, column 5, lines 30-35. By this rationale claims 3, 10 and 17 are rejected.

9. In regard to claims 4, 11 and 18, Pannu is applied as in claims 1, 8 and 15. Pannu further discloses *means for assigning a temporary tag for the second data and placing the temporary tag into the first data when the second data is separated from the first data, said inserting means replacing the temporary tag with the identifier that permits retrieval of the second data*. Pannu states the e-mail may include HTML. See Pannu, column 4, line 46. An inherent aspect of HTML is the use of tags to represent items such as hyperlinks to documents. Upon opening the message including HTML tags in an enhanced email program, said HTML tags pointing to hyperlinks will be replaced within the message by hyperlinks. By this rationale claims 4, 11 and 18 are rejected.

10. In regard to claims 5 and 12, Pannu is applied as in claims 1 and 8. Pannu further discloses *the communication line comprises the Internet*. See Pannu, column 3, lines 65-67. By this rationale claims 5 and 12 are rejected.

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11. In regard to claims 6, 13 and 25, Pannu is applied as in claims 1, 8 and 23. Pannu further discloses *the second data comprises an attached file*. See Pannu, column 4, lines 40-42. By this rationale claims 6, 13 and 25 are rejected.

12. In regard to claims 7, 14 and 26, Pannu is applied as in claims 1, 8 and 23. Pannu further discloses *the second data comprises at least one of graphic data and a computer executable program*. See Pannu, column 4, lines 40-42. By this rationale claims 7, 14 and 26 are rejected.

13. In regard to claims 19, 21, 22 and 27, Pannu is applied as in claims 1, 8, 15 and 23. Pannu further discloses *the identifier comprises a URL*. See Pannu, column 4, lines 42-44. By this rationale claims 19, 21, 22 and 27 are rejected.

14. In regard to claim 24, Pannu is applied as in claim 23. Pannu further discloses *the first data comprises text data*. Pannu discloses an e-mail message that includes a link to another document. An e-mail message would inherently include text data. By this rationale claim 24 is rejected.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pannu.

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17. In regard to claim 28, Pannu is applied as in claim 23. Pannu fails to disclose appending the identifier to an end of the first data [putting the hyperlink at the end of the text]. However, Pannu discloses that the e-mail message is HTML enhanced. See Pannu, column 4, line 46. HTML allows tags and links to be placed at any point in the document. It would be obvious to one of ordinary skill in the art at the time of the invention to put a link at any specific point in an e-mail message, including at the end of the first data [text], in order to indicate where the sender would like the link to be located in the message to allow for a pleasing layout for the user. By this rationale claim 28 is rejected.

Response to Arguments

18. The Examiner has acknowledged above the receipt of the certified copy of the priority documents submitted by Applicant.

19. As stated previously, Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendments were substantial enough to warrant a new art search.

20. Upon reviewing the newly amended claims, the Examiner has understood what Applicant is claiming to be a form of enhanced e-mail utilizing HTML tags and hyperlinks. The Pannu reference that the Examiner has presented sufficiently predates the priority given to the certified Japanese patent application submitted by Applicant. Pannu presents a form of e-mail which includes HTML hyperlinks. The Examiner believes that the Pannu references teaches all aspects of Applicant's claimed invention.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571-272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JPS


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